

**UNITED STATES COURT OF APPEALS FOR THE FEDERAL
CIRCUIT**

2007-1221
(Interference No. 105,455)

IN RE HAROLD R. GARNER,

Appellant,

On Appeal from the Board of Patent Appeals and Interferences,
Patent Interference No. 105,455

REPLACEMENT BRIEF OF APPELLANT HAROLD R. GARNER

June 19, 2007

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UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

Harold R. Garnerv. Calvin E. Quate and David SternNo. 2007-1221

CERTIFICATE OF INTEREST

Counsel for the (petitioner) (appellant) (respondent) (appellee) (amicus) (name of party),
appellant certifies the following (use "None" if applicable; use extra sheet
 if necessary):

1. The full name of every party or amicus represented by me is:

Harold R. Garner

2. The name of the real party in interest (if the party named in the caption is not the real
 party in interest) represented by me is:

NimbleGen Systems Inc.

3. All parent corporations and any publicly held companies that own 10 percent or more
 of the stock of the party or amicus curiae represented by me are:

None

4. ☒ There is no such corporation as listed in paragraph 3.

5. The names of all law firms and the partners or associates that appeared for the party
 or amicus now represented by me in the trial court or agency or are expected to appear in this
 court are:

Quarles & Brady LLP, Anthony A. Tomaselli, Kristin Graham Noel, and Nicholas J. Seay

5/14/07

Date

Anthony A. Tomaselli
 Signature of counsel

Anthony A. Tomaselli
 Printed name of counsel



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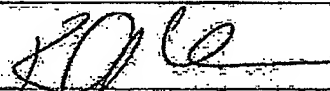
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UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

Harold R. Garnerv. Calvin F. Quate and David SternNo. 2807-1221

CERTIFICATE OF INTEREST

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Quarles & Brady LLP, Anthony A. Tomaselli, Kristin Graham Noel, and Nicholas J. Seay

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STATEMENT OF RELATED CASES

Pursuant to Federal Circuit Rule 47.5 the Court is advised that:

- (a) No other appeal from the Board of Patent Appeals and Interferences ("Board") in connection with Interference No. 105,455 has been brought before this or any other court.
- (b) Counsel knows of no other case pending in this or any other court that will directly affect or be directly affected by this Court's decision in the pending appeal.

STATEMENT OF JURISDICTION

The Federal Circuit has jurisdiction over this appeal under 28 U.S.C. § 1295(a)(4)(A), which gives this Court exclusive jurisdiction “of an appeal of a decision of the Board of Patent Appeals and Interferences of the United States Patent and Trademark Office with respect to patent applications and interferences.” Additionally, this Court has jurisdiction under 35 U.S.C. § 141, which states that a “party to an interference dissatisfied with the decision of the Board of Patent Appeals and Interferences on the interference may appeal the decision to the United States Court of Appeals for the Federal Circuit.”

STATEMENT OF THE ISSUE PRESENTED FOR REVIEW

1. Whether Garner’s showing of priority, if unrebutted, would support a determination of priority in favor of Garner and is sufficient to suggest an interference under 37 C.F.R. § 41.202. (AD 27-28).
2. Whether documents that Garner had previously filed with the Patent and Trademark Office (“PTO”) during the prosecution of the application should be considered by the Board when determining whether Garner had made a sufficient showing under 37 C.F.R. § 41.202.

STATEMENT OF THE CASE

Inventor Harold Garner filed his provisional patent application a mere six (6) days after Appellees Quate and Stern. Thus, to suggest an interference against U.S. Patent No. 6480,324, 37 C.F.R. § 41.202 required Garner to make a *prima facie* showing that he reduced his invention to practice at least six days before he filed his application. He did so. Garner not only filed photographs of the invention with his own declaration establishing his invention was reduced to practice months before he filed his provisional patent application, he also filed sworn statements from a member of the laboratory who witnessed the invention and laboratory notebook pages signed by others further corroborating it. In declaring Interference No. 105,455, the Board held Garner's showing insufficient and issued an order to show cause. In response, Garner explained his initial showing by referencing documents that had been previously submitted to the PTO, such as the specification of the underlying patent application. The Board refused to consider such documents, classifying them as "new evidence." Garner appeals the Board's ruling on sufficiency and the Board's definition of "new evidence."

STATEMENT OF FACTS

I. SUMMARY OF THE INVENTION

The subject of this appeal involves the use of a computer to create a microarray by controlling the way light hits a substrate. (JA 85). When the light hits the substrate, it interacts with light-sensitive chemicals on the surface of the substrate, causing a chemical reaction in the limited area where the light hits the substrate, thereby deprotecting a nucleotide and permitting another nucleotide to extend an oligonucleotide chain. (JA 89-91). This chemical reaction creates a space for another molecule to bind to the substrate. (Id.). Oligonucleotide microarrays of exquisite specificity are created through a high density series of these chemical reactions.

The count of the interference is drawn to "an apparatus for catalyzing a reaction on a substrate comprising: a light source; a computer-controlled micromirror positioned to redirect light from the light source toward the substrate; and a reaction chamber, wherein light redirected by the micromirror catalyzes a chemical reaction proximate the substrate in the reaction." (JA 155, ll. 16-21). Thus, the invention includes three elements: (1) a light source; (2) a computer-controlled micromirror; and (3) a reaction chamber. (Id.).

Before this invention, a slide similar to a photographic negative was placed between the light source and the substrate to control the flow of light. (JA 86-87). The slide, also known as a mask, contained dark portions that block light and light portions that allowed light to pass. (JA 86-91). Garner's invention, marketed as a Maskless Array Synthesizer, eliminates the need for slides or masks. (JA 93). Instead, a computer is used to control the angle of tiny mirrors. (JA 94). The computer adjusts the mirrors to shine light as needed, easily creating a new pattern without the need to physically create a new mask. (JA 93-94).

II. PROCEDURAL HISTORY

The subject of this Appeal, U.S. Patent Application No. 09/998,341 ("the Garner Application"), was filed by Garner on November 29, 2001. (JA 176 ¶1). The Garner Application is a continuation of U.S. Patent Application No. 09/776,202 filed nine months earlier, which, in turn, is a divisional of U.S. Patent Application No. 09/326,526 filed on June 4, 1999. (JA 142-43). U.S. Patent Application No. 09/326,526 claims priority to Provisional Application No. 60/087,948 filed on June 4, 1998. (JA 86). Because this provisional application discloses the count of the interference at issue, Garner is entitled to an apparent constructive reduction to practice date of June 4, 1998. (JA 45-84).

Quate and Stern filed U.S. Provisional Application No. 60/087,333 claiming a similar invention on May 29, 1998, *six days* before Garner's provisional application filing date. (JA 140). Quate later filed a utility patent application claiming priority to their May 29, 1998 provisional application. This application issued as Patent No. 6,480,324 ("the Quate patent"). (JA 31-41).

To provoke an interference with the Quate patent, Garner amended the Garner Application to copy Quate's claims. (JA 129-137). Because the Quate patent priority date was six days earlier than Garner's priority date, Garner was required to provide evidence, which, if unrebutted, would be sufficient to support a determination of priority in his favor. 37 C.F.R. § 41.202. Garner's showing had to establish that his invention was completed before Quate's priority date, and satisfied the elements of the count. In fact, as the prosecution history already established, Garner had conceived of this invention months earlier and had already constructed a working prototype by August 1997 -- six months before the May 1998 date Garner was required to pre-date to provoke an interference under § 41.202. (See e.g., JA 113-127; 176-189). Nevertheless, because of his filing date, Garner was named the junior party in Interference No. 105,455 declared on September 6, 2006. (JA 190-195).

A. Prosecution History of the Garner Application

During prosecution of the Garner Application, Garner established that he successfully constructed the claimed device prior to February 1998. In a related application, No. 09/776,202, the examiner rejected the claimed invention based on two cited patent applications published in February 1998. In response to these rejections, Garner submitted a "Declaration Under 37 C.F.R. § 1.131 of Prior Invention in the United States to Overcome Cited References" that he signed on November 28, 2001 (hereafter "the 2001 Garner declaration"). (JA 113-122). The Garner 2001 declaration stated that the photograph attached as Exhibit A "was taken in August 1997 and demonstrated that the device as claimed had been built and was operating." (JA 113 ¶4). Additionally, the Garner 2001 declaration stated that:

[T]his affidavit in conjunction with the affidavit under 37 C.F.R. § 1.131 filed in the parent application demonstrated that the device was used to form a mask pattern formed and printed using the present device, and was therefore reduced to practice in the United States prior to the filing date of the art used for rejection.

(JA 114 ¶4).

Submitted as exhibits to the Garner 2001 declaration were two photographs of the device, as well as copies of laboratory notebook pages dated November 11, 1997. (JA 115-122). One photograph depicted the device as it appeared in the lab. (JA 115). The other photograph, showing

the same device, was edited to label the key components. (JA 116). The laboratory notebook pages included a photocopy of a successfully created pattern, labeled "mask," as well as descriptions of the chemical reactions taking place during the successful operation of the machine, labeled as "chemistry of a successful run." (JA 117, 119).

When Garner abandoned the '202 application in favor of the Garner Application, the examiner imposed the same rejections. In response, Garner resubmitted the Garner 2001 declaration along with a similar 1.131 declaration (hereinafter "the Garner 2003 declaration") with the same exhibits. (JA 176-189). As a result of these two declarations and their attached exhibits, the examiner removed his objections and allowed the prosecution of the application to proceed. Another similar Garner declaration was filed to overcome art from February 1998 that was cited in other related applications. (JA 123-127). As a result, before an interference was ever suggested, Garner had established an invention date before February 1998.

B. Rule 202(d) Showing of Priority

Because the Garner priority date was later than Quate's May 29, 1998 priority date, Garner was required in seeking to provoke an interference to make a *prima facie* showing that he invented the claimed device prior to

May 29, 1998. (JA 140-141). As noted above, since Garner had previously established an invention date prior to February 1998, Garner resubmitted the Garner 2001 declaration along with the declaration of corroborating witness John Fondon (hereinafter referred to as the "Fondon Declaration"). (JA 134; 176-189; 138-139).

Dr. Fondon, now a professor at the University of Texas Southwestern, witnessed the Maskless Array Synthesizer while working in Garner's laboratory. (JA 135; 138). In the Fondon declaration, Dr. Fondon states that he saw the device in the attached photograph in November 1997. (JA 138 ¶4). The attached photograph showed the same device pictured in the attachment to the Garner 2001 declaration. (JA 139; 180).

After receiving the declarations in support of Garner's request for an interference, the examiner advised Garner that the submitted 37 C.F.R. § 1.131 declaration could not satisfy 37 C.F.R. § 41.202 because the declaration must be a declaration under 37 C.F.R. § 41.202. (JA 7 ll. 1-3). To comply, Garner retitled the previously submitted § 1.131 declaration as a § 41.202 declaration and resubmitted the newly titled declaration on January 26, 2006, without substantive change. (JA 7 ll. 10; 166-175).

C. Board's Rulings

Ultimately, the Board held that the Garner 2001 declaration and the Fondon declaration failed to establish an actual reduction to practice because the declarations failed to "show or explain how each of the elements illustrated in the photograph operationally interacted with each other" or "how the content of the notebook pages relates to the device purportedly shown in the photograph." (JA 147, ll. 18-19; JA 148, l. 8). Additionally, in the Board's opinion, the Digital Light Processor ("DLP") could not be considered as the equivalent of a computer controlled micromirror because the abbreviation "DLP" was not adequately defined. (JA 148-149, ll. 23-30; 1-3). The Board ordered Garner to show cause why a judgment should not be entered against him in the interference. (JA 150, ll. 23-25).

Shortly after issuing the Order to Show Cause, the Board issued an Order stating that "new evidence" of priority would not be admitted except on a showing of good cause. (JA 152, ll. 4-5). In footnote 1 of this Order, the Board defined "new evidence," as "[a]ny new testimony from any witness for demonstrating priority of invention constitutes new evidence." (JA 152).

In response, Garner explained his initial showing by referencing five documents previously submitted to the PTO during the application's prosecution history: (1) Garner's provisional application, Serial No. 60/087,948, the provisional application to which the application at issue claims priority (JA 45-84); (2) the specification of the Garner Application (JA 85-109); (3) "Declaration Under 37 C.F.R. § 1.131 of Prior Invention in the United States to Overcome Cited References" signed by Garner on August 22, 2003 (JA 176-189); (4) "Declaration Under 37 C.F.R. § 41.202(d)" signed by Garner on December 8, 2005 (hereinafter "the Garner 2003 declaration" (JA 166-175); and (5) "Declaration" signed by John Fondon on October 20, 2005 (JA 138-139). These documents illuminated Garner's initial showing by clarifying how the claimed elements illustrated in the photograph interacted and further corroborating Garner's evidence of the device's successful use. (JA 154-165).

For example, the specification of the Garner Application explained that "DLP" referred to a Digital Light Processor, which is also known as a computer-controlled micromirror device. (JA 94). When the application was read in conjunction with the annotated photograph submitted in Garner's 202(d) showing, the picture clearly illustrated a light source, a DLP, or a computer-controlled micromirror device, and a reaction chamber.

The cited Garner '948 provisional application likewise addressed concerns raised by the Board. For example, because the provisional application contains clearer photocopies of the resulting patterns, these photocopies illustrate that the light and dark patterns that were created by the device resemble a tick-tack-toe board, with perpendicular dark lines or a checkerboard pattern with alternating light and dark squares. (JA 81). By comparing these pictures to the picture attached to the Garner 2001 declaration, the picture can more easily be understood as showing a successful result (e.g., the checkerboard pattern). (JA 81; 117).

The Garner 2003 declaration referenced in Garner's response also addressed the mask-like pattern created by the device. (JA 176-189). Garner there stated that "Figure 7 in the present application is a rendering of the original photograph with which the provisional application, to which this application claims priority, was filed that shows an actual fluorochrome bound to a phosphoramidite base on a slide." (JA 177 ¶10).

The Board refused to consider all of the documents submitted in Garner's response to the order to show cause, choosing to ignore: (1) the specification of the provisional application (JA 45-85); (2) the Garner Application (JA 85-109); and (3) the Garner 2003 declaration (JA 176-189). (JA 4-26). Despite previously defining "new evidence" as "new testimony

from a witness,” the Board reverted to its interpretations of former Rules 608 and 617 (JA 9-12; AD 29; AD 30-31) and classified the three previously submitted documents as “new evidence.” (JA 152; 4-26). According to 37 C.F.R. § 41.202(d), “new evidence” could not be submitted without a showing of good cause, which Garner did not attempt to make, because he believed the contents of the application’s prosecution history to be competent evidence available to the Board. As a result, the Board refused to consider relevant evidence. (JA 4-26). In a final decision issued on December 14, 2006, the Board, without considering these documents, awarded judgment on priority as to Count 1 against Garner. (JA 1).

SUMMARY OF ARGUMENT

The Board made two errors during the interference. First, the Board incorrectly ruled that Garner’s initial showing was inadequate. Substantial evidence established that the initial showing adequately supported a determination of priority in Garner’s favor. Second, the Board erred when it refused to consider documents previously submitted as part of the application’s prosecution history, because it classified such documents as “new evidence.” Classifying documents already before the PTO as “new evidence” for the purposes of Rule 202(d) is arbitrary, capricious, and an abuse of discretion.

ARGUMENT

I. STANDARD OF REVIEW

This Court's standard of review of decisions of the Board is set forth in the Administrative Procedure Act. 5 U.S.C. § 706. In re McDaniel, 293 F.3d 1379, 1382 (Fed. Cir. 2002). "Priority and its issues of conception and reduction to practice are questions of law predicated on subsidiary factual findings." Taskett v. Dentlinger, 344 F.3d 1337, 1339 (Fed. Cir. 2003). This Court "reviews without deference the Board's legal conclusions on priority, conception, and reduction to practice." Brown v. Barbacid, 276 F.3d 1327, 1332 (Fed. Cir. 2002). In contrast, the Board's factual findings are reviewed for "substantial evidence." 5 U.S.C. § 706(2)(E); In re Gartside, 203 F.3d 1305, 1313-15 (Fed. Cir. 2000). "The 'substantial evidence' standard asks whether a reasonable fact finder could have arrived at the agency's decision." Gartside, 203 F.3d at 1312.

Appellate courts are to "set aside legal actions of the Board that are 'arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law.'" In re McDaniel, 293 F.3d at 1382, quoting 5 U.S.C. § 706; In re Gartside, 203 F.3d 1305, 1316 (Fed. Cir. 2000). "An abuse of discretion occurs if the decision is (1) clearly unreasonable, arbitrary, or fanciful; (2) is based on an erroneous conclusion of law; (3) rests on clearly erroneous fact

findings; or (4) involves a record that contains no evidence on which the Board could rationally base its decision.” Eli Lilly & Co. v. Bd. of Regents of the Univ. of Wash., 334 F.3d 1264, 1266-67 (Fed. Cir. 2003). This Court applied a *de novo* standard of review to the PTO’s interpretation of its own reissue rule in Dethmers Mfg. Co., Inc. v. Automatic Equip. Mfg. Co., 272 F.3d 1365, 1370 (Fed. Cir. 2001).

II. THE BOARD’S DECISION THAT GARNER’S SHOWING WAS INSUFFICIENT IS NOT SUPPORTED BY SUBSTANTIAL EVIDENCE.

A. Garner’s 202(d) Showing Was Sufficient To Establish A *Prima Facie* Case.

Garner’s initial showing sufficiently established a *prima facie* showing of priority. In order to establish a *prima facie* showing, “Garner must provide evidence, which if unrebutted, is sufficient to support a determination of priority in his favor.” (JA 141, ll. 2-3) “In order to establish an actual reduction to practice, the inventor must prove that: (1) he constructed an embodiment or performed a process that met all the limitations of the interference count; and (2) he determined that the invention would work for its intended purpose.” Taskett, 344 F.3d at 1340. Additionally, an inventor’s testimony regarding the facts of the invention must be corroborated by independent evidence. Brown, 276 F.3d at 1335. Garner met the requirements set forth in Taskett because he established that

all the limitations of the count had been met, that the invention worked for its intended purpose, and that the success of the invention was corroborated by an independent observer.

1. Garner constructed an embodiment that met all the limitations of the interference count.

Garner established that he constructed a device that met all of the limitations of the interference count. The interference count requires an apparatus having three elements: (1) “a light source”; (2) “a computer controlled micromirror positioned to re-direct light from the light source toward the substrate”; and (3) “a reaction chamber, wherein the light redirected by the micromirror catalyzes a chemical reaction” on the substrate. (JA 155, ll. 16-21). The Garner declaration references a photograph of the invention, stating that the picture was “taken in August 1997 and demonstrates that the device as claimed had been built and was operating prior to the filing date of the reference cited as prior art in the parent application of this filing.” (JA 166, ¶4). Because the cited document was dated February 1998, this statement indicates that the device as claimed was built prior to February 1998, and certainly, therefore, prior to Quate’s May 29, 1998 filing date. (JA 166, ¶1). Because Garner’s declaration is a sworn statement (JA 167, ¶ 7), Garner’s assertion that the device as claimed

operated prior to the filing date should have been accepted as *prima facie* evidence that the device operated prior to the Quate priority date.¹

Garner's § 202(d) showing also included photographs depicting the three key elements: a light source, a micromirror, and a reaction chamber. (JA 168-169). The light source was circled and labeled "UV light source" in the annotated version of the photographs. (JA 168). The computer controlled micromirror was demonstrated by: (1) the picture of a computer and monitor and (2) the specific labels illustrating the various parts of the computer controlled micromirror unit. (JA 168) These labels included "Monitor," "DLP driver boards," "DLP (pre-counting under foil)," and "DLP power supply." (JA 168). Finally, the picture identified a "reaction chamber mount" and depicted a reaction chamber within the mount. (JA 168). Thus, all three elements were embodied in the device. (JA 115, 116, 168, 169).

The Board incorrectly found Garner's showing inadequate, based on the erroneous conclusion that the picture did not contain a micromirror. (JA

¹ Paragraph 7 states that "I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both . . . and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon." (JA 167, ¶7)

148-149). DLP is an abbreviation for "Digital Light Processor" commonly used by those skilled in the art as is shown by the fact that the Quate Patent uses the same abbreviation. (JA 38). The abbreviation was also explained in the response to an Office Action that was submitted with Garner's 202(d) showing (JA 130-136), which stated that "DLP refers to a digital light programming device which is the same thing as the 'computer-controlled micromirror.'" (JA 134). As an abbreviation recognized by those skilled in the art and explained by Garner's 202(d) showing, the Board erred when it refused to recognize "DLP" as a reference to a computer-controlled micromirror.

2. Garner submitted evidence showing a successful chemical reaction on a substrate indicating the device worked for its intended purpose.

Garner established that the device was successfully used to create a mask pattern on a substrate. Specifically, Garner's declaration states that "this affidavit in conjunction with the affidavit under 37 C.F.R. § 1.131 filed in the parent application demonstrated that the device was used to form a mask pattern formed and printed using the present device, and was therefore reduced to practice in the United States." (JA 166-167, ¶4). The affidavit filed in the parent application states that "[f]rom the lab notebook pages attached hereto as Exhibit A, it can be seen that the invention in this

application was used to produce a mask pattern on a substrate.” (JA 123, ¶5).

Evidence of success is further established by the lab notebook pages attached to both the Garner 2001 and the Garner 2005 declarations. (JA 125-127; 170-175). These attachments both include a lab notebook page titled “Chemistry of successful run” followed by a sequence of chemical reactions. (JA 127; 172). Another page shows the word “mask” with an arrow pointing to a picture indicating that this picture was recognized as showing a mask-like pattern in November 1997 -- six months prior to the date Garner needed to pre-date. (JA 126; 171). Although the signatures on the bottom of these pages are admittedly difficult to read, the signatures on other copies submitted to the PTO show that the pages were not authored by inventor Garner. (JA 185; JA 160-161). They evidence success as recognized by other disinterested parties. (JA 185). These pages, along with the related declarations establish a *prima facie* case for successful operation of the invention.

3. The successful function of the apparatus was corroborated.

John Fondon’s declaration states that he witnessed a prototype of the claimed invention in November 1997. (JA 138). Additionally, the photograph attached to the provisional application showing the mask

patterns support Garner's statement that the device worked for its intended purpose prior to the filing of the application. (JA 81). As previously noted, notes on a laboratory notebook indicating a successful run were authored by individuals other than Garner. The cumulative effect of these various references corroborate Garner's testimony.

**B. The Initial Showing is Intended to Be a Low Burden;
However the Practical Effect of the Board's Scrutiny
Resulted in an Unfairly High Burden.**

In effect, the Board's definition of "new evidence" applies an unwarranted heightened level of scrutiny to the initial showing. The Board uses three levels of evidentiary standards to evaluate evidence of priority: (1) clear and convincing evidence; (2) a preponderance of the evidence; and (3) a *prima facie* showing. The highest standard applied to a showing of priority, clear and convincing evidence, is appropriate only after an interference is already underway and the Board is evaluating the priority of an application that was filed after the issuance of a patent. Bruning v. Hirose, 161 F.3d 681, 684 (Fed. Cir. 1998). The mid-level standard, preponderance of the evidence is likewise appropriate only after the Board has determined that the interference has been adequately suggested and is evaluating priority between an issued patent and an application that was co-pending with the application for the issued patent. Id. at 686. In contrast,

the *prima facie* showing, the lowest standard, is the appropriate standard when the Board is determining whether an interference is warranted. By defining “new evidence” in a way that excludes relevant evidence already in the record before the agency, and by questioning the quality and the validity of evidence not excluded, the Board, in effect, applied a heightened standard that should only be invoked after an interference is declared.

Under the proper standard, Garner’s showings were sufficient. To be sufficient, “a showing of priority need not anticipate all possible bases for opposing the showing.” Rule of Practice Before the Board of Patent Appeals and Interferences, 68 FR 66648, 2003 WL 22794143 (Nov. 26, 2003). (AD 32). For example, “when the applicant’s earliest constructive reduction to practice of the interfering subject matter occurred before the apparent earliest constructive reduction to practice of a targeted patent, it would typically suffice for the applicant to show precisely where its earliest constructive reduction to practice was disclosed.” Id.

Garner complied with the standard set out in the above noted notice of rule making, one of the few resources available to offer guidance on the proper interpretation of Rule 202. Specifically, Garner pointed to references already in the record to “show precisely where its earliest constructive reduction to practice was disclosed.” Id.

After an applicant put forth evidence establishing his priority, challenges to the sufficiency of evidence are intended to be raised during the interference, not prior to it. In this case, rather than accepting as sufficient the sworn statements indicating that the device was constructed and functioning well before May 1998, the Board raised a number of questions to rebut evidence in the initial showing. (JA 146-150) For example, the Board disqualified some of Garner's evidence because he used abbreviations, rather than complete phrases, all of which would have been known to the skilled artisan and which were noted in the file history. The Board should not have used this vehicle to challenge whether those skilled in the art accept the abbreviations as commonly understood within the art.

By making the initial showing a significant obstacle to overcome, the PTO shirks its proper role and extending the requirements of the initial showing beyond reasonable bounds. See Price v. Symsek, 988 F.2d 1187, 1195 (Fed. Cir. 1993) (holding that the Board extended its corroboration standards beyond reasonable bounds when it failed to consider all the evidence of record collectively). Under the U.S. "first-to-invent" system, the PTO determines the priority of patents. By defining "new evidence" in a way that makes interferences overly difficult to suggest, the PTO deters worthy applicants from establishing rights to their inventions, while at the

same time, forcing overburdened courts to make determinations regarding priority. See Eli Lilly & Co. v. Bd. of Regents of the Univ. of Wash., 334 F.3d 1264 (Fed. Cir. 2003) (Lourie, J. dissenting) (“It is clearly more efficient for even an overburdened Patent Office to make determinations in the arcane world of interferences than for the overburdened courts to do so”). The Board’s unusual scrutiny of Garner’s submissions has simply resulted in an appeal to the Court. The matter of priority should have been fully heard on the merits by the Board without requiring appeal to the Court for preliminary procedural review.

III. THE BOARD ABUSED ITS DISCRETION BY INCORRECTLY CLASSIFYING PREVIOUSLY SUBMITTED MATERIALS IN THE RECORD AS “NEW EVIDENCE.”

A. The Board’s Definition Of Previously Submitted Materials As “New Evidence” Is Contrary To The Plain Language Of The Regulation.

Finding Garner’s 202(d) showing unclear, the Board ordered Garner to show cause why a judgment should not be entered against him. Garner did so, and clarified his initial showing by reference to materials already in the PTO record. The Board rejected these references, holding that they consisted of “new evidence.” This Court should reverse that finding because the Board’s definition of “new evidence” is contrary to the plain meaning of the unambiguous regulation.

The Board's interpretation of Rule 202(d) does not flow plainly, clearly, or unambiguously from the language of the rule and is therefore an abuse of discretion. To interpret a regulation, this Court looks at the regulation's plain language and considers the common meaning of the terms. Lockheed Corp. v. Widnall, 113 F.3d 1225, 1227 (Fed. Cir. 1997). If the Court concludes "that the terms of the regulation are unambiguous, no further inquiry is usually required." Tesoro Haw. Corp. v. United States, 405 F.3d 1339, 1347 (Fed. Cir. 2005).

For example, when considering the meaning of "borrowings," this Court considered the dictionary definition of the word "borrow" in the context of the scope and language of the regulation in which it was used. Lockheed Corp., 113 F.3d at 1227. Finding the dictionary definition to be consistent with the term's usage within the regulation, this Court concluded that the language of the regulation was clear and the commonly understood definition was applied to the facts of the case. Id.

In this case, the meaning of 37 C.F.R. § 41.202(d) is plain: "[n]ew evidence in support of priority will not be admitted except on a showing of good cause." 37 C.F.R. § 41.202(d). "New" is generally defined as "recently come into being" or "recently discovered." Black's Law Dictionary, Eighth Edition (2004). Under this definition, it is absurd to

apply the term "new" to the specification of the very application that is the subject of the interference -- an application that was submitted to the PTO more than five years before the Board classified it as "new evidence." The commonly understood definition of "new" is likewise inapplicable to Garner's other evidence, all of which had long since been submitted to the PTO during the prosecution of the application at issue. Because regulations "must not be construed to produce absurd and whimsical results," the Board abused its discretion by interpreting 202(d) to exclude evidence previously submitted to the PTO such as the very application at issue. Steuer v. United States, 207 Ct. Cl. 282, 294 (1975) citing Church of the Holy Trinity v. United States, 143 U.S. 457, 460 (1892).

B. Even If The Regulation Is Found To Be Ambiguous, The Board Abused Its Discretion By Defining "New Evidence" So That Material Previously Submitted To The PTO Would Not Be Considered.

The Board's interpretation is not entitled to discretion for four reasons: (1) the Board's interpretation violates two fundamental canons of statutory construction; (2) the Board's interpretation is inconsistent with the Board's own previous definition; (3) the Board's interpretation contradicts basic policies related to priority determinations; and (4) the Board's interpretation contradicts definitions used by other agencies. If the language of the regulation is ambiguous, an agency's interpretation is entitled to

deference as long as its interpretation is neither plainly erroneous nor inconsistent with the regulation. Gose v. United States Postal Serv., 451 F.3d 831, 836 (Fed. Cir. 2006). “Deference is particularly appropriate when the agency’s interpretation has been consistently applied.” Id. “Conversely, ‘an agency’s interpretation of a statute or regulation that conflicts with a prior interpretation is ‘entitled to considerably less deference’ than a consistently held agency view.’” Id. quoting Thomas Jefferson Univ. v. Shalala, 512 U.S. 504, 515, 114 S. Ct. 2381 (1994). Thus, the Supreme Court has refused to follow administrative guidelines when they have conflicted with earlier pronouncements of the agency. Gose, 451 F.3d at 837-38.

1. The Board’s interpretation of “new evidence” violates two fundamental canons of statutory construction.

The Board’s definition of “new evidence” is clearly erroneous because by characterizing material previously submitted to the PTO as “new evidence” the Board has violated two fundamental canons of statutory construction: (1) the Board has created a conflict between the proper interpretation of two subsections within the same regulation, namely 41.202(a)(5) and 41.202(d)(2); and (2) the Board’s definition of “new evidence” has rendered the showing of good cause meaningless. In light of these two errors in interpretation, the Board abused its discretion.

- a. **The Board's interpretation of "new evidence" creates internal inconsistencies within § 41.202 and is therefore clearly erroneous.**

One provision of a statute or regulation should not be construed to cause conflict with another provision. United States v. Moore, 95 U.S. 760, 762-63 (1878). Rather, "the construction should be such that both provisions, if possible, may stand." Id. at 763. In this case, because both subsections relate to the same topic, the process an applicant must take to suggest an interference, they should be interpreted consistently. By defining "new evidence" in way that causes conflict regarding the application of the sections, the Board abused its discretion.

The conflict arises when the PTO's instructions regarding the proper application of § 41.202(a)(5) are compared to the Board's definition of "new evidence." For example, subsection (a)(5) states that when suggesting an interference, an applicant must "provide a claim chart showing the written description for each claim in the applicant's specification" if a claim has been added or amended to provoke an interference. 37 C.F.R. § 41.202(a)(5). The notice of rule making issued by the PTO explains that § 41.202(a)(5) is intended to "continue the practice under Rule 633(a) of looking at the applicant's specification to determine the meaning of a copied claim." Rule of Practice Before the Board of Patent Appeals and

Interferences, 68 FR 66648, 2003 WL 22794143 (Nov. 26, 2003). Thus, the Board is expected to consider the specification of the application at issue when evaluating the applicant's claim chart.

In contrast, under the Board's interpretation of "new evidence," the specification of the application at issue cannot be considered when evaluating the sufficiency of a priority showing made under § 41.202(e) unless the specification was first re-submitted to the PTO as part of the applicant's showing. It is absurd to assume that the authors of § 41.202 intended the Board to consider the specification when determining whether the applicant complied with subsection (a), while at the same time, intending the same specification to become "new evidence" during the showing of priority for purposes of subsection (d). Both subsection (a) and subsection (e) address the elements an applicant must satisfy to suggest an interference. As such, the Board should either consider the application when evaluating all of the rule's subsections or refuse to consider the application when evaluating any of the rule's subsections. Requiring the Board to consider the application's specification under (a), but then requiring the applicant to resubmit the very same specification if it is to be considered under (d), is an illogical abuse of discretion.

b. The Board's definition of "new evidence" has rendered the applicant's showing of cause meaningless.

By interpreting "new evidence" to exclude all evidence not submitted in the initial 202(d) showing, the Board has effectively rendered meaningless the applicant's right to show cause and is, therefore, an abuse of discretion. A statute or regulation "is to be read in its entirety, in a logical and common sense manner so as to give effect to all of its parts." New York Life Ins. Co. v. United States, 190 F.3d 1372, 1382 (Fed. Cir. 1999) (internal citations omitted).

Rule 202(d)(2) gives an applicant the ability to show cause why judgment should not be entered against the applicant if the applicant's initial showing was found to be insufficient. 37 C.F.R. § 41.202. By defining "new evidence" to include documents such as the very application at issue in the interference, the Board blinds itself to the most relevant documents and, in the process, eliminates an applicant's ability to compose a meaningful response to the order to show cause. Without a meaningful ability to respond, the Board, in effect, eliminates an applicant's option to respond and renders Rule 202(d)(2) meaningless. Because regulations, like statutes, must be interpreted in a common sense manner giving meaning to all subsections, the Board's interpretation of "new evidence" is an abuse of discretion.

2. The Board's interpretation is inconsistent with its previous definition.

In addition to creating internal inconsistencies within the regulation, the Board's interpretation of "new evidence" is inconsistent with its own previous definition of "new evidence." Prior to Garner's response to the Board's Order to Show Cause, the Board issued an order stating that Garner shall not submit new evidence of priority unless and until the Board has ruled that good cause exists. (JA 152). As a footnote to this statement, the Board expressly clarified the meaning of new evidence by stating that "[a]ny new testimony from any witness for demonstrating priority of invention constitutes new evidence." (JA 152). Not until the Board's Decision on Order to Show Cause did the Board first define "new evidence" as any information not part of Garner's initial showing. (JA 4-26). If the Board had always defined "new evidence" as any information not part of an applicant's initial showing of priority, then this definition should have been used to clarify "new evidence" in the Board's Miscellaneous Order. Instead, "new evidence" was defined as "new testimony from any witness for demonstrating priority." Changing the definition of "new evidence" after Garner complied with the definition initially articulated is an abuse of discretion.

In support for its position that Garner's response contained "new evidence," the Board relied on the interpretation of former Rules 617 and 608. The Board's reliance on previous interpretations of former rules is misplaced. Rather the starting point for interpretation "is the existing statutory text, and not the predecessor." Lamie v. United States Tr., 540 U.S. 526, 534, 124 S. Ct. 1023, 1030 (2004).

Additionally, the former regulations contain two significant differences that make reliance on their former interpretations inappropriate. First, and most significantly, if 37 C.F.R. § 1.608 (2004) was in effect, this appeal would be unnecessary because an interference would have been declared without requiring an initial priority showing. Under the former rules, when the effective filing date of an application was no more than three months after the effective filing date of a patent, an interference could be declared without a *prima facie* showing of priority. 37 C.F.R. § 1.608 (2004). Rather, a *prima facie* showing was required only if the effective filing date of the application was more than three months after the effective filing date of the patent. In this case, Garner's application was filed *six days* after the effective filing date of Quate's Patent. As a result, under the former rules that the Board relies on to define "new evidence," a showing of priority would not even be required.

A second significant difference between the current and former rules is that the former rules explicitly referenced additional evidence that “was not initially presented with the evidence filed under § 1.608(b).” The former rules never used the term “new evidence” and when the former rules referenced evidence not initially filed under the former rule, they did so explicitly. Thus, had the PTO intended “new evidence” to be defined as the Board has interpreted it, the regulation should have referred explicitly to information not included in the initial showing, as it had before. Thus, the interpretation of the old rules is an inappropriate guide to the interpretation of the new rules.

3. The Board’s definition of “new evidence” contradicts basic policies related to priority determinations.

Defining “new evidence” to mean relevant evidence already submitted to the PTO contradicts basic policies related to priority determinations. When determining priority, an inventor’s testimony must be corroborated. Brown, 276 F.3d at 1335. Whether an inventor’s testimony has been sufficiently corroborated is determined by a “rule of reason” analysis, in which “an evaluation of all pertinent evidence must be made so that a sound determination of the credibility of the inventor’s story may be reached.” Price, 988 F.2d at 1195. Because “all evidence of record must be collectively evaluated,” an inventor can prove prior conception “although no

one piece of evidence in and of itself establishes the prior conception.” Id. at 1196. For example, in Price, this Court vacated a Board’s decision in part because the Board rejected individual evidence for lack of sufficiency, while failing to consider the record as a whole. Id.

The Board made a similar error in this case, taking a greater interest in technicalities than in inventorship. The Board’s current interpretation of “new evidence” prevented it from considering relevant evidence regarding priority and caused it to lose sight of the ultimate purpose of an interference -- to determine who first invented the claimed invention. See Chisum on Patents § 10.09.

For example, the Board refused to consider the exhibits attached to Garner’s 2003 declaration, which indicated that the laboratory notebook pages were authored by non-inventors. (JA 16). As a result, the Board made a priority determination before the interference even started. The Board did so without the benefit of relevant corroborating evidence that was then before it, despite well-settled case law requiring the consideration of relevant evidence before the agency. The Board’s abuse of discretion denied Garner the benefit of the process, procedures, and protections the interference procedure is intended to provide.

4. The Board's definition of "new evidence" contradicts definitions used by other agencies.

By defining "new evidence" to include documents previously submitted to the PTO, the Board took an overly formalistic and rigid position that is contrary to the definition applied by other administrative agencies. Traditionally, agencies consider "new evidence" to consist of "evidence not previously submitted to agency decision makers" or evidence that is "not merely cumulative of other evidence on the record." Anglin v. West, 203 F.3d 1343, 1345 (Fed. Cir. 2000). Thus, when considering whether evidence was "new" for purposes of a veteran appeal, this Court affirmed the decision of the Board of Veterans' Appeals when it determined that evidence including medical records, insurance documents and testimony was not "new" because it was cumulative of the evidence in the record at the time the Board made its decision. Id. at 1346-47. Likewise, other circuits have applied similar definitions, concluding that "the proper interpretation is that the administrative record consists of materials in the agency record *at the time the decision was made.*" Haynes v. United States, 891 F.2d 235, 238 (9th Cir. 1989) (emphasis in original). Such rulings are consistent with the Federal Administrative Procedure Act ("APA"), which requires that "the transcript of testimony and exhibits, together with all papers and requests

filed in the proceeding,” be made part of the administrative record. 5 U.S.C. 556(e).

Applying Anglin, Haynes and the APA to this case, the documents submitted by Garner are not be “new” because they are identical to documents previously submitted to the PTO during the prosecution of the Garner Application and should, therefore, already be part of the record. Furthermore, classifying figures and statements within the very application at issue as “new” defies all common sense. As the Supreme Court recently noted, “[r]igid preventative rules that deny factfinders recourse to common sense, however, are neither necessary under our case law nor consistent with it.” KSR Int’l Co. v. Teleflex Inc., 2007 U.S. LEXIS 4745, *42 (Apr. 30, 2007). As such, the Board’s exclusion of documents already in the record before the PTO was an abuse of discretion.

CONCLUSION

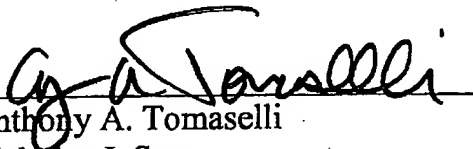
The Board committed two errors in the Garner/Quate interference. First, the Board erred when it concluded that Garner’s initial showing was insufficient to suggest an interference. Garner’s initial showing established that Garner’s invention embodied the three key elements of the interference count, worked for its intended purpose, and that its success could be corroborated by independent witnesses and contemporaneously-recorded

documents. As such, this showing was sufficient. Second, the Board erred by defining "new evidence" to include evidence previously submitted to the Board. Based on this erroneous definition, the Board excluded relevant evidence at the cost of a substantive and fair determination of inventorship. As such, it was an abuse discretion and should be reversed.

STATEMENT OF RELIEF SOUGHT

Garner requests that the Board's decision as it relates to the sufficiency of Garner's showing be overturned and that the case be remanded with instructions to re-open the interference. If the Court denies that relief, Garner requests that the Court overrule the Board's interpretation of "new evidence" and instruct the Board to consider the documents referenced in Garner's Response to Order to Show Cause filed on September 26, 2006.

Dated this 19th day of June, 2007.


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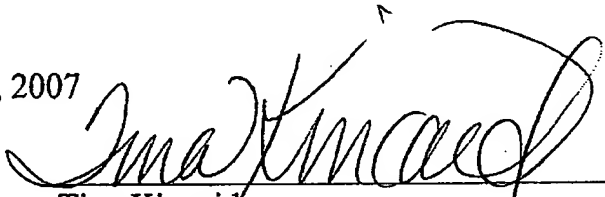
CERTIFICATE OF SERVICE

I, Tina Kincaid, am over the age 18 years of age and am not a party to the above action. I am an employee of Quarles & Brady LLP, 33 East Main Street, Suite 900, Madison, Wisconsin 53703. On the below date, in the ordinary course of business, I served two copies of the Brief of Appellant Harold R. Garner via Overnight Delivery to the below listed attorneys of record in this action.

Via Overnight Mail

Stephen Walsh
Thomas L. Stoll
United States Patent & Trademark Office
Madison West, 8C43
600 Dulany Street
Alexandria, Virginia 22314


Dated this 19th day of June, 2007


Tina Kincaid

**CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME
LIMITATION, TYPEFACE REQUIREMENTS,
AND TYPE STYLE REQUIREMENTS**

1. This brief complies with the type-volume limitation of Federal rule of Appellate Procedure 32(a)(7)(B). The brief contains 7592 words, excluding the parts of the brief exempted by Federal Rule of Appellate Procedure 32(a)(7)B(iii) and Federal Circuit Court Rule 32(b).
2. This brief complies with the typeface requirements of Federal Rule of Appellate Procedure 32(a)(5) and the type style requirements of Federal Rule of Appellate Procedure 32(a)(6). The brief has been prepared in a proportionally spaced typeface using Microsoft Word 2003 in 14 Times Roman font.

Dated this 19th day of June, 2007



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ADDENDUM

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Paper 37

Filed: December 14, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES
(Administrative Patent Judge Jameson Lee)

HAROLD R. GARNER
Junior Party
(Application 09/998,341)

v.

CALVIN F. QUATE
and
DAVID STERN
Senior Party
(Patent 6,480,324)
Patent Interference No. 105,455 (JL)
(Technology Center 1600)

Before SCHAFER, LEE, and MOORE, Administrative Patent Judges.

MOORE, Administrative Patent Judge.

JUDGMENT - Bd. R. 127(a)

Garner has failed to explain why judgment should not be entered against it based upon its failure to establish that it could prevail on the issue of priority, 37 CFR § 41.202(d) (2005).
Upon consideration of the decision on the Order to Show Cause, it is ORDERED that judgment on priority as to Count 1 (the sole count in the interference, Paper 1, page 4) is awarded against Junior Party Harold R. Garner

-1-

AD0001

1 **FURTHER ORDERED** that Junior Party Harold R. Garner is not entitled to a
2 patent containing claims 39, 41-48 and 50-58 (corresponding to Count 1) of application
3 09/998,341.

4 **FURTHER ORDERED** that if there is a settlement agreement, attention is
5 directed to 35 U.S.C. § 135(c).

6 **FURTHER ORDERED** that a copy of this JUDGMENT and accompanying
7 DECISION shall be placed in the files of (1) application 09/998,341 and (2) U.S. Patent
8 6,480,324.

 /Richard E. Schafer/
 ADMINISTRATIVE PATENT JUDGE

 /Jameson Lee/
 ADMINISTRATIVE PATENT JUDGE

 /James T. Moore/
 ADMINISTRATIVE PATENT JUDGE

)
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Paper 36

Filed: December 14, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES
(Administrative Patent Judge Jameson Lee)

HAROLD R. GARNER
Junior Party
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v.

CALVIN F. QUATE
and
DAVID STERN
Senior Party
(Patent 6,480,324),
Patent Interference No. 105,455 (JL)
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Before SCHAFER, LEE, and MOORE, Administrative Patent Judges.

MOORE, Administrative Patent Judge.

1 Decision on Order to Show Cause - Bd. R. 202(d)

2

3 A. Introduction

4 1. Presently before the Board is a response (Paper 15) by Garner to an order to
5 show cause (Paper 3).

1 2. The order to show cause ordered Garner to explain why judgment should not
2 be entered against it based upon its failure to establish that it could prevail on the issue
3 of priority. 37 CFR § 41.202(d) (2005).

4 3. For the reasons which follow, we hold that Garner has not shown good cause
5 for admitting the evidence provided in its response to the order to show cause and
6 decline to admit it.

7 4. For the reasons which follow, we hold that Garner has not adequately
8 explained why judgment should not be entered against it based on its Bd. R. 202(d)
9 submissions to the examiner.

10 5. Accordingly, at this time it is appropriate to enter judgment against Garner.

11 B. Findings of Fact

12 1. This interference was declared September 5, 2006. (Paper 1).

13 2. Junior Party Garner, the applicant, provoked the interference. (Paper initially
14 submitted October 24, 2005 in Application 09/998,341).

15 3. The October 24, 2005 submission in Application 09/998,341 contained two
16 declarations, one by John Fondon dated October 20, 2005 (hereinafter Fondon I) and
17 one by Harold Garner dated November 28, 2001 (hereinafter Garner I).

18 4. Interferences are discretionary with the Director of the United States Patent
19 and Trademark Office. See, e.g. 35 U.S.C. §135(a) ("Whenever an application is made
20 for a patent which, in the opinion of the Director, would interfere with any pending
21 application, or with any unexpired patent, an interference may be declared. . .")
22 (emphasis added).

1 5. The Director has set forth rules for the conduct of interferences. See, e.g. 37
2 CFR § 41 (2004).

3 6. To avoid potential harassment of patentees by applicants, one of the rules
4 imposed by the Director is 37 CFR § 41.202 (2004) which governs suggesting
5 interferences.

6 7. 37 CFR § 41.202 provides in pertinent part as follows:

7 § 41.202 Suggesting an interference.

8
9 (a) Applicant. An applicant, including a reissue applicant, may suggest an
10 interference with another application or a patent. The suggestion must:

11 (4) Explain in detail why the applicant will prevail on priority.

12
13
14
15
16 (d) Requirement to show priority under 35 U.S.C. 102(g)

17
18 (1) When an applicant has an earliest constructive reduction to practice
19 that is later than the apparent earliest constructive reduction to practice for
20 a patent or published application claiming interfering subject matter, the
21 applicant must show why it would prevail on priority.

22
23 (2) If an applicant fails to show priority under paragraph (d)(1) of this
24 section, an administrative patent judge may nevertheless declare an
25 interference to place the applicant under an order to show cause why
26 judgment should not be entered against the applicant on priority. New
27 evidence in support of priority will not be admitted except on a showing of
28 good cause. The Board may authorize the filing of motions to redefine the
29 interfering subject matter or to change the benefit accorded to the parties.

30
31 (e) Sufficiency of showing.

32
33 (1) A showing of priority under this section is not sufficient unless it would,
34 if un rebutted, support a determination of priority in favor of the party
35 making the showing.

1 8. The examiner in Application 09/998,341 advised Garner that the 37 CFR
2 § 1.131 submission was insufficient for a 37 CFR § 41.202. (Office Action, December
3 27, 2005).

4 9. A second opportunity to comply with Bd. R. 202(d) was permitted by the
5 Examiner in Application 09/998,341 (Office Action December 27, 2005).

6 10. A second request was filed on January 26, 2006 in Application 09/998,341,
7 including a "Declaration Under 37 C.F.R. § 41.202(d)" signed December 8, 2005 by
8 inventor Garner with attachments (hereinafter Garner II) and a second copy of the
9 Fondon I declaration (Fondon II) and attachments.

10 11. The second request was substantively the same as the first request.

11 12. Simultaneous with the Declaration of this Interference on September 6,
12 2006, the Board placed the Applicant under an order to show cause (Paper 3).

13 13. The Board in paper 3 again determined that the totality of the showing
14 provided by Garner under 37 CFR § 41.202(d) from these three sources was
15 insufficient, if un rebutted, to support a determination of priority in favor of Garner.

16 14. Accordingly, Garner was ordered to show cause why judgment should not be
17 entered against it. (Paper 3).

18 15. Garner has responded with Paper 15 on September 26, 2006.

19 16. Garner does not challenge the findings of the show cause order of Paper 3.

20 17. Instead, Garner responds to the show cause order by going through the
21 prosecution history of application 09/998,341 for additional evidence in support of its
22 originally filed 202(d) showing.

1 18. Paper 15 asserts that it relies on no new evidence, but "evidence of record"
2 (Paper 15, page 1, line 5).

3 19. As Garner has misconstrued rule 202(d), it is evident that an amplified
4 discussion of rule 202(d) is warranted here.

5 C. Discussion

6 i) The History and Function of a 202(d)(1) Showing

7 Interferences are lengthy, complicated, and expensive proceedings. A form of
8 summary judgment, such as that provided by Rule 202(d)(2) is one way to reduce the
9 costs associated with interferences.

10 Initially, the PTO implemented summary judgment proceedings in interferences
11 in 1965 by amending 37 CFR §1.204(b), and adding 37 CFR §1.204(c) and 1.228. (29
12 Fed. Reg. 15866 (Nov. 26, 1964)).

13 Former rule 204(c) provided that:

14 When the effective filing date of an applicant is more than 3 months
15 subsequent to the effective filing date of the patentee, the applicant,
16 before the interference will be declared, shall file two copies of affidavits or
17 declarations by himself, if possible, and by one or more corroborating
18 witnesses, supported by documentary evidence if available, each setting
19 out a factual description of acts and circumstances performed or observed
20 by the affiant, which collectively would entitle him to an award of priority
21 with respect to the effective filing date of the patent. This showing must
22 be accompanied by an explanation of the basis on which he believes that
23 the facts set forth would overcome the effective filing date of the patent.
24 Failure to satisfy the provisions of this section may result in summary
25 judgment against the applicant under §1.228. (37 CFR §1.204(c)(1965))

26
27 In short, if a junior party applicant didn't have the proof up front, that
28 applicant lost.
29
30

1 As noted in Kistler v. Weber, 412 F.2d 280, 285, 162 USPQ 214, 218-219 (CCPA
2 1969) " [t]he expense involved in a protracted interference, and the special hardships
3 workable on a patentee involved therein, are notorious, and to minimize both, where
4 possible, would appear to be the laudable purpose of these rules. If a junior party
5 [applicant] is in fact 'a first inventor' and if he could prove that in a 'full hearing on
6 priority,' we see no reason why he should be prejudiced or unduly burdened by a
7 requirement that he prove (prior to a 'full hearing') by way of affidavits and documentary
8 evidence that he is at least prima facie entitled to an award of priority over the
9 patentee's effective filing date."

10 However, those rules were not without administrative difficulties for the agency
11 resulting from defective initial showings. When rule 204(c) and 228 were replaced with
12 rules 617 and 608 in 1984, the PTO observed during the rule making process that:

13 Section 1.617 retains summary judgment proceedings in those cases
14 where a junior party applicant is required to file evidence and an
15 explanation under § 1.608(b). To avoid summary judgment, the junior
16 party applicant must establish that it is prima facie entitled to judgment
17 relative to the senior party patentee. For the most part, practice under §
18 1.617 will be the same as the current practice under 37 CFR 1.228. The
19 major changes would be the following: (1) A prima facie case could be
20 based on patentability as well as priority. (2) A stricter standard would be
21 imposed for presenting additional evidence after entry of an order to show
22 cause. Under current practice (37 CFR 1.228), additional evidence may be
23 submitted with a response to an order to show cause "when a showing in
24 excuse of . . . [its] omission from the original" showing is made. The
25 "good cause" showing required by § 1.617(b) imposes a stricter
26 standard than was required under the prior rules. The stricter
27 standard is necessary to encourage applicants copying claims from
28 a patent to better prepare their initial showings under proposed §
29 1.608(b). Under current practice, the Board of Patent Interferences
30 has found that substantial time is lost in issuing orders to show
31 cause based on an inadequate initial showing only to have an

1 adequate showing made with the response to the order to show
2 cause. Under the "good cause" standard, ignorance by a party or
3 counsel of the provisions of the rules or the substantive
4 requirements of the law would not constitute good cause. (49 FR
5 3775, col. 1)(Emphasis Added).
6

7 In other words, in the period leading up to 1984, the Board was facing a problem
8 of inadequate initial showings which wasted time and Board resources in having to
9 review a second submission when there was no reason the arguments and evidence
10 had not been provided earlier.

11 Rule 617 was explained by the Federal Circuit as implemented to practice
12 Hahn v. Wong, 892 F.2d 1028, 13 USPQ2d 1313 (Fed. Cir. 1989) "tighten" up on initial
13 showings because the "public interest requires the prompt resolution of interferences
14 and not piecemeal prosecution." See Hahn v. Wong, 13 U.S.P.Q.2d 1211, 1214 (Bd.
15 Pat. App. & Interf. 1989). There are several reasons why this step was taken by the
16 Director - to manage a process more efficiently, limit patentee exposure to harassment,
17 and reduce overall pendency of interferences and applications involved in interferences
18 with concomitant patent term extension.

19 As noted in HR 6286, the Patent Law Amendments Act of 1984:

20 The longest interference took over 13 years in the Patent and Trademark
21 Office. While most interferences are not that long, the substantial delays in
22 issuing a patent due to the lengthy interference proceedings and
23 subsequent ex parte proceedings are harmful to both applicants and the
24 public. Lack of confidence in the patent law system is the ultimate result.
25 In response to the problem, the Patent and Trademark Office already has
26 published regulations to streamline this process (49 Fed. Reg. 3788 (Jan.
27 30, 1984)). (Congressional Record, October 1, 1984, H10525-29).
28

1 It was the intent of the Director to limit the problem of multiple attempts to make
2 out a prima facie case that the applicant would prevail on priority with the promulgation
3 of former rules 617 and 608(b).

4 Former rules 608(b) and 617 provide as follows, in pertinent part:

5 §1.608 (b) When the earlier of the filing date or the effective filing date of
6 an application is more than three months after the earlier of the filing date
7 or the effective filing date under 35 U.S.C. 120 of a patent, the applicant,
8 before an interference will be declared, shall file (1) evidence which may
9 consist of patents or printed publications, other documents, and one or
10 more affidavits which demonstrate that applicant is prima facie entitled to
11 a judgment relative to the patentee and (2) an explanation stating with
12 particularity the basis upon which the applicant is prima facie entitled to
13 the judgment. Where the basis upon which an applicant is entitled to
14 judgment relative to a patentee is priority of invention, the evidence shall
15 include affidavits by the applicant, if possible, and one or more
16 corroborating witnesses, supported by documentary evidence, if available,
17 each setting out a factual description of acts and circumstances performed
18 or observed by the affiant, which collectively would prima facie entitle the
19 applicant to judgment on priority with respect to the earlier of the filing date
20 or effective filing date of the patent. . . (37 CFR §1.608(b)(1984))

21
22 §1.617 Summary judgment against applicant.

23
24 (a) An examiner-in-chief shall review any evidence filed by an applicant
25 under §1.608(b) to determine if the applicant is prima facie entitled to a
26 judgment relative to the patentee. If the examiner-in-chief determines that
27 the evidence shows the applicant is prima facie entitled to a judgment
28 relative to the patentee, the interference shall proceed in the normal
29 manner under the regulations of this part. If in the opinion of the examiner-
30 in-chief the evidence fails to show that the applicant is prima facie entitled
31 to a judgment relative to the patentee, the examiner-in-chief shall,
32 concurrently with this notice declaring the interference, enter an order
33 stating the reasons for the opinion and directing the applicant, within a
34 time set in the order, to show cause why summary judgment should not be
35 entered against the applicant.

36
37 (b) The applicant may file a response to the order and state any reasons
38 why summary judgment should not be entered.
39

1 This higher standard requiring "good cause" is discussed in Basmadjian v.

2 Landry 54 USPQ2d 1617, 1621 (Bd. Pat. App. & Interf. 1997)(Precedential):

3 [a]dditional evidence shall not be presented by the applicant or considered
4 by the Board unless the applicant shows good cause why any additional
5 evidence was not initially presented with the evidence filed under §
6 1.608(b). Id. [37 CFR §1.617(b)] The "good cause" standard was first
7 promulgated in the 1984 amendments to the interference rules. Notice of
8 Final Rule, supra. [49 Fed. Reg. 84816, 48421 col. 3 (Dec. 12, 1984)]. In
9 addition to the Notice of Final Rule, a discussion of the "good cause"
10 standard can be found in Hahn v. Wong, 892 F.2d 1028, 13 USPQ2d
11 1313 (Fed. Cir. 1989). Before 1984, supplemental evidence would be
12 accepted upon a "showing in excuse of *** [the] omission [of the
13 supplemental evidence] from the original showing." 37 CFR § 1.288
14 (1984). The language of Rule 288 set "no standard for showing in
15 excuse." Nakayama v. Banner, 588 F.2d 1336, 1342-43, 200 USPQ 266,
16 270 (CCPA 1978). Under the "good cause" standard of 37 CFR §
17 1.617(b), ignorance by a party or counsel of the provisions of the rules or
18 the substantive requirements of the law would not constitute good cause.
19 Notice of Final Rule, supra at 48423, 1050 Off. Gaz. Pat. Office at 392. Or
20 the other hand, "good cause" might be shown if evidence first comes into
21 existence after a Rule 608(b) showing is filed. Huston v. Ladner, 973 F.2d
22 1564, 1566, 23 USPQ2d 1910, 1912-13 (Fed. Cir. 1992) ("if the evidence
23 was not available when the original showing was filed, this would have
24 been a valid excuse for not filing the evidence"). Another basis upon which
25 "good cause" might be established would be where a diligent effort to find
26 evidence was unsuccessful prior to filing the Rule 608(b) showing, but
27 continued diligence ultimately succeeded in locating the evidence after the
28 showing was filed. Whether an applicant has shown "good cause" is a
29 matter within the discretion of the board. Hahn v. Wong, supra at 1034, 13
30 USPQ at 1318.

31
32 Current Rule 202(d) carries forward to the present day the intent of former rules
33 617 and 608(b) in ensuring the showing is complete at the start, with all necessary
34 evidence submitted with the showing.

35 In the notice of rulemaking, the PTO stated:

36 Proposed § 41.202(d) would set forth the basis for a summary proceeding
37 when an applicant does not appear to be able to show it would prevail on

1 priority. Proposed § 41.202(d)(1) would restate Rule 608, but would
2 eliminate the distinction between Rule 608(a) and Rule 608(b). The
3 requirement could be made under 35 U.S.C. 132 even when a rejection is
4 not available. Failure to comply with the requirement would result in
5 abandonment of the application under 35 U.S.C. 133. Proposed
6 § 41.202(d)(2) would restate Rule 617 by providing a basis for a summary
7 proceeding on priority when the applicant fails to make a sufficient
8 showing of priority. To be sufficient under proposed § 41.202(e), the
9 showing would by itself, if un rebutted, have to warrant a determination of
10 priority. (68 FR 66664, col. 3)(Nov. 26, 2003)(emphasis added).

11 Accordingly, Rule 202(d) now focuses on the showing, by itself, and the evidence
12 contained therein, as the record for consideration in any show cause order. Anything
13 else is "new" evidence, even if it is contained elsewhere in the PTO.

14 ii) Portions of Garner's Evidence Now Relied Upon are

15 The Evidence

16 Bd. R. 202(d)(2) permits an administrative patent judge to declare an interference
17 to place an applicant under an order to show cause. Bd. R. 202(d)(2) expressly
18 provides that "[n]ew evidence in support of priority will not be admitted except on a
19 showing of good cause."

20 Garner states that "... Garner relies on the following pieces of evidence of
21 record." (Paper 15, page 1, lines 6-7). Garner then lists 5 pieces of "evidence."

22 We address each piece of "evidence."

23 1. The specification of Garner provisional application number 69/087,948.

24 This specification is not part of Garner's 202(d)(1) showing submitted January
25 26, 2006 or its predecessor of October 24, 2005. At best, Garner mentioned the
26 provisional application in passing by noting that priority is claimed to the provisional
27

1 application. No argument pointing specifically to any specific evidence provided at the
2 time of the 202(d) statement was made in the 202(d)(1) statement. Accordingly, this is
3 precisely the type of "new evidence" rule 202(d) is designed to prevent from being
4 admitted without good cause.

5 2. The specification of the Garner application involved in this interference, Serial
6 Number 09/998,341.

7 Again, this specification is not part of Garner's 202(d)(1) showing submitted
8 January 26, 2006 or its predecessor of October 24, 2005. Furthermore, Garner did not
9 make any mention of any particular portion of the specification or any reason why that
10 specification should be utilized in the 202(d)(1) statement to support its showing. Again,
11 this is precisely the type of "new evidence" rule 202(d) is designed to prevent from being
12 admitted without good cause.

13 3. A document entitled "Declaration Under 37 C.F.R. §1.131 of Prior Invention in
14 the United States to Overcome Cited References" signed by Inventor Harold R. Garner
15 on August 22, 2003 and submitted to the Patent and Trademark Office in conjunction
16 with a response filed September 2, 2003, and Exhibits thereto. (hereinafter Garner X).

17 Again, by Garner's own admission (Paper 15, page 2, lines 4-5), the Garner X
18 declaration did not form part of the 202(d)(1) submission. It is, likewise, new evidence
19 for purposes of the order to show cause and the showing.

20 4. A document entitled "Declaration Under 37 C.F.R. §41.202(b)" signed by the
21 Inventor Harold R. Garner on December 8, 2005, and submitted to the Patent and

1 Trademark Office in conjunction with a document mailed January 26, 2006, and exhibits
2 thereto. (Garner II).

3 Garner II (and Garner I in October, 2005) were filed as part of the 202(d)(1)
4 showing and are properly evidence to be considered as to whether the 202(d)(1)
5 showing was sufficient.

6 5. A document entitled "Declaration" signed by John Fondon on October 20
7 2005 and submitted to the Patent and Trademark Office in conjunction with a document
8 mailed January 26, 2006, and attached exhibit. (Fondon II).

9 Fondon II (and Fondon I in October, 2005) were filed as part of the 202(d)(1)
10 showing and are properly evidence to be considered as to whether the 202(d)(1)
11 showing was sufficient.

12 Rule 202(d)(2) issues a direct warning - "[n]ew evidence in support of priority will
13 not be admitted except on a showing of good cause."

14 The determination whether a party seeking to initiate an interference has shown
15 'good cause' for his failure to present the additional evidence at the time of his initial
16 submission is a matter within the discretion of the Board. *Huston v. Ladner*, 973 F.2d
17 1564, 1566, 23 USPQ2d 1910, 1912 (Fed. Cir. 1992) citing *Hahn v. Wong*, 892 F.2d
18 1028, 1034, 13 USPQ2d 1313, 1318 (Fed. Cir. 1989) (discussing comparable prior Board
19 Rule 608). Good cause, in terms of a prior Rule 608 showing in an interference, has
20 been described as including, *inter alia*, a reason why the evidence was not available
21 and could not have been presented with the motion or any other valid reason.
22 Excluded from good cause is attorney conduct. See, e.g. *Huston* 973 F.2d at 1566, 23

1 USPO2d at 1912-1913; Notice of Final Rule, Patent Interference Proceeding, 49
2 Fed. Reg. 48416, 48423 (Dec. 12, 1984). Bd. R. 202(d) has the same "good cause"
3 requirement.

4 The proof standards applicable to situations such as this one are discussed in
5 *Basmadjian v. Landry*, 54 USPO2d 1617 (Bd. Pat. App. & Int. 1997).

6 Garner has not shown, nor attempted to show, good cause for the late
7 submission of the first three pieces of evidence as part of its showing. As a
8 consequence, we shall not consider the first three pieces of new evidence. Were we to
9 do otherwise in this instance, the PTO's clearly stated purpose for the good cause
10 requirement, streamlining and keeping the process efficient, would be stymied and
11 frustrated. What if we were to consider this evidence, and it were insufficient, and there
12 were yet additional pieces of new evidence that Garner could exhume from a related
13 application? Would we be required to give Garner a third chance? That is not the
14 purpose of Bd. R. 202. The applicant, in requesting an interference, is to present its
15 case fully, accompanied by its evidence, if it is titularly the junior party. The Board
16 cannot be expected to prospect in the records of the PTO for possible evidence
17 supporting the movant's case in making its initial decision.

18 The time to show that one has sufficient evidence to prove one's case is at the
19 time of the 202(d)(1) submission. The place for one to do it is in the 202(d)(1)
20 submission. The evidence must be within the 202(d)(1) submission, relied upon and
21 discussed in the submission, or the applicant invites catastrophe.

1 iii) The Evidence Remaining in the Showing is Insufficient

2 What then, is left in the response?

3 The count is claim 39 of the instant application, which reads as follows:

4 An apparatus for catalyzing a reaction on a substrate, comprising:
5 a light source;
6 a computer controlled micromirror positioned to redirect light from the light source
7 toward the substrate; and
8 a reaction chamber, wherein the light redirected by the micromirror catalyzes a
9 chemical reaction proximate the substrate in the reaction.

10 The Applicant was aware that it needed to comply with the requirements of Bd.
11 R. 202 at the time of its initial attempt to provoke an interference (Page 2 of Arguments
12 submitted October 24, 2005). Indeed, the applicant observed that the requirement was
13 similar to prior Bd. R. 608 which required the applicant to make a prima facie case of
14 why it will prevail on priority (Page 3).

15 Garner's earliest apparent constructive reduction to practice date is June 4, 1998
16 (filing date of 60/087,948), which is after Quate's apparent constructive reduction to
17 practice date of May 29, 1998 (filing date of 60/087,333) (Paper 1, page 4). Garner was
18 therefore required to present evidence sufficient to prove a date of invention of the
19 subject matter of the proposed count before May 29, 1998. Garner's evidence must
20 have been sufficient to support a determination of priority in his favor. 37 CFR §
21 41.202(e).

22 "[P]riority of invention goes to the first party to reduce an invention to practice
23 unless the other party can show that it was the first to conceive of the invention and that
24 it exercised reasonable diligence in later reducing that invention to practice." *Medichem*
25

1 S.A. v. Rolabo S.L., 437 F.3d 1167, 1169, 77 USPQ2d 1865, 1873 (Fed. Cir. 2006)
2 quoting Cooper v. Goldfarb, 154 F.3d 1321, 1327, 47 USPQ2d 1896, 1901 (Fed. Cir.
3 1998).

4 Garner's attempt to meet Bd. R. 202(d) asserts only an earlier actual reduction to
5 practice. It is unnecessary, therefore, to consider conception and diligence.

6 "In order to establish an actual reduction to practice, the inventor must prove
7 that: (1) he constructed an embodiment or performed a process that met all the
8 limitations of the interference count; and (2) he determined that the invention would
9 work for its intended purpose." Taskett v. Dentlinger, 344 F.3d 1337, 1340, 68 USPQ2d
10 1472, 1474 (Fed. Cir. 2003) quoting Cooper, 154 F.3d at 1327, 47 USPQ2d at 1901.

11 In addition, an inventor's testimony as to the facts of the invention must be
12 corroborated by independent evidence. Cooper, 154 F.3d at 1330, 47 USPQ2d at 1903
13 ("In order to establish an actual reduction to practice, an inventor's testimony must be
14 corroborated by independent evidence."); Hahn v. Wong, 892 F.2d at 1032-33, 13
15 USPQ2d at 1317 (Fed. Cir. 1989); Reese v. Hurst, 661 F.2d 1222, 1225, 211 USPQ
16 936, 940 (CCPA 1981).

17 When considering the sufficiency of corroborating evidence a reasonableness
18 standard is used. Scott v. Finney, 34 F.3d 1058, 1061-62, 32 USPQ2d 1115, 1118 (Fed.
19 Cir. 1994); Holmwood v. Sugavanam, 948 F.2d 1236, 1238, 20 USPQ2d 1712, 1714
20 (Fed. Cir. 1991). Whether a putative inventor's testimony has been sufficiently
21 corroborated is determined by a "rule of reason" analysis, in which "an evaluation of all
22 pertinent evidence must be made so that a sound determination of the credibility of the

1 inventor's story may be reached." *Price v. Symsek*, 988 F.2d 1187, 1195, 26 USPQ2d
2 1031, 1037 (Fed. Cir. 1993). However, that "rule of reason" analysis does not alter the
3 requirement of independent corroboration of an inventor's testimony. *Brown v.*
4 *Barbacid*, 276 F.3d 1327, 1335, 61 USPQ2d 1236, 1240 (Fed. Cir. 2002). The inventive
5 facts must not rest alone on testimonial evidence from the inventor himself. *Brown*, 276
6 F.3d at 1335, 61 USPQ2d at 1240; *Cooper*, 154 F.3d at 1330, 47 USPQ2d at 1903.

7 The evidence is *Gamer I*, *Gamer II*, and *Fondon I and II*, *Gamer X* (September
8 2, 2003), and the arguments pertaining to it (comprising the bulk of the Response,
9 Paper 15), have not been considered.

10 *Gamer's* first request for an interference (October 25, 2005) argued that the
11 declarations showed that *Gamer* had actually reduced the invention of the count to
12 practice before the effective filing date of the application that issued as the Quate patent
13 and was, therefore, *prima facie* entitled to priority.

14 *Gamer's* counsel argued that an annotated photograph contained in the
15 declarations of *Gamer* accomplished this:

16 The photograph contains all elements of the count. In the left hand portion
17 of the photograph as Exhibit B is a UV light source which meets the
18 requirement of Claim 39 that there be an ultraviolet light source in the
19 claimed apparatus. Further, in the photograph marked Exhibit B there is a
20 "DLP" connected to a DLP driver board and a DLP power supply. DLP
21 refers to a digital light programming device which is the same thing as the
22 "computer controlled micromirror position to redirect light from the light
23 source toward the substrate" as presently recited in Claim 39 of this patent
24 application. Also shown in the photograph in Exhibit B is a "reaction
25 chamber mount" containing the reaction chamber, which is the same thing
26 as the element recited in Claim 39 of "a reaction chamber, wherein light
27 redirected by the micromirror catalyzes a chemical reaction proximate the
28 substrate in the reaction." The substrate reaction is contained within the

1 reaction chamber in the reaction chamber mount and the successful
2 catalysis of the reaction is demonstrated by the chemistry of the
3 successful run which is contained in Exhibit C3 attached to the Declaration
4 by inventor Garner. (Paper submitted October 25, 2005, unpaginated,
5 under "Evidence of Priority")
6

7 It is well established that the remarks of counsel are no substitute for evidence.

8 See *Estee Lauder Inc. v. L'Oreal, S.A.*, 129 F.3d 588, 595, 44 USPQ2d 1610, 1615

9 (Fed. Cir. 1997) (Argument of counsel cannot take the place of evidence lacking in the
10 record).

11 Garner's complete testimony on the reduction to practice of the subject matter of
12 the proposed count is reproduced below:

13 4. To establish the date of completion of the invention of this
14 application, the following copies of a presentation related to a grant
15 application is attached hereto as Exhibit A and submitted as evidence.
16 The photograph in Exhibit A was taken in August 1997 and demonstrates
17 that the device as claimed had been built and was operating prior to the
18 filing date of the reference cited as prior art in the parent application of this
19 filing. Exhibit A, attached hereto demonstrates that the device as claimed
20 had been not only conceived but reduced to practice before the filing date
21 of the art cited in the parent application. Furthermore, this affidavit in
22 conjunction with the affidavit under 37 C.F.R. §1.131 filed in the parent
23 application demonstrated that the device was used to form a mask pattern
24 formed and printed using the present device, and was therefore reduced
25 to practice in the United States prior to the filing date of the art used for
26 the rejection.
27

28 5. From the lab notebook pages attached hereto as Exhibit A, it can
29 be seen that the invention in this application was used to produce a mask
30 pattern on a substrate on the date even therewith, which is on or before
31 February 23, 1998, which is a date earlier than the effective date of the
32 reference cited in the parent application. (Garner I, pp. 1-2.)
33

34 Garner I also refers to and relies upon a declaration filed "in the parent case,"

35 Application 09/326,526. That declaration is not in evidence. Even were we to assume it

1 were appropriate to incorporate it by reference, it merely states that the laboratory
2 notebook pages attached to the declaration show that "invention in the application" was
3 used to produce a mask pattern on a substrate on or before February 23, 1998.

4 Application 09/326,526, Declaration filed March 1, 2001, pp. 1-2. (hereinafter
5 Garner 0).

6 Garner's complete testimony relating to the date of the invention from Garner 0 is
7 as follows:

8 4. To establish the date of completion of the invention of this
9 application, the following copies of lab notebook pages are attached
10 hereto as Exhibit A and submitted as evidence.

11
12 5. From the lab notebook pages attached hereto as Exhibit A, it can
13 be seen that the invention in this application was used to produce a mask
14 pattern on a substrate on the date even therewith, which is on or before
15 February 23, 1998, which is a date earlier than the effective date of the
16 reference. (Application 09/326,526, Declaration filed March 1, 2001, pp.
17 1-2.)

18
19 Exhibit A is a photograph of a machine with labels added. We are not informed
20 who added the labels, or when the labels were added. Did counsel label the machine,
21 or is it an original from the grant presentation? There is no testimony as to the meaning
22 of or accuracy of the labels.

23 In sum, the evidence from each of Garner 0, I, and II shows:

24 (1) a machine was built by August 1997.

25 (2) a mask pattern may have been formed on a substrate.

26 In evaluating a priority showing under § 41.202(d) we look to the count proposed
27 by the applicant pursuant to § 41.202(a)(2).

1 The count is directed to an apparatus for catalyzing a reaction on a substrate,
2 comprising:

3
4 (1) a light source;

5
6 (2) a computer controlled micromirror positioned to redirect light from the light
7 source toward the substrate; and

8
9 (3) a reaction chamber, wherein the light redirected by the micromirror catalyzes
10 a chemical reaction proximate the substrate in the reaction.

11
12 To show priority, Garner had to prove, with corroborated evidence, that each of
13 the above elements of the apparatus were present, worked as intended, and catalyzed
14 a chemical reaction proximate the substrate in the reaction.

15 Garner 0, Garner 1, Garner II, Fondon I, and Fondon II, with the attachments
16 submitted with the declarations, do not show that the specific elements of the proposed
17 count were present and worked for their intended purpose.

18 Garner testified that the device shown in the copy of the photograph in "Exhibit A"
19 was built and operating in August 1997. Garner 0, Garner 1, pp. 1-2. Garner does not
20 testify in either declaration as to the specific operating parts of the device. The
21 photograph of the device did not show how each part of the device worked as described
22 in the count. Consequently, Garner did not provide sufficient evidence to carry its
23 burden of proof that the elements of the count were present in the machine depicted in
24 the photographs.

25 Even were we to accept somehow the labels on the photograph as "evidentiary"
26 in nature (we do not), they would still fall short of showing each part of the device. For
27 example, the presence of a "reaction chamber mount" does not establish that there was

1 a reaction chamber present "wherein the light redirected by the micromirror catalyzes a
2 chemical reaction proximate the substrate in the reaction." Additionally, the presence
3 of a "DOC Process Control Computer," a "DLP," "DLP Driver Boards," and a "fluid
4 injection stage" does not establish that there was "a computer controlled micromirror
5 positioned to redirect light from the light source toward the substrate," counsel's
6 assertions notwithstanding.

7 Garner also testified that the lab notebook pages show that the invention in the
8 application was used to produce a mask pattern on a substrate before February 23,
9 1998. Garner I, pp. 1-2. However, Garner did not explain the content of the notebook
10 pages and how those pages demonstrate that the light redirected by the micromirror
11 catalyzes a chemical reaction proximate the substrate in the reaction." Nor did Garner
12 explain how the content of the notebook pages relate to the device purportedly shown in
13 the photograph.

14 From a review of the submitted notebook pages, the computer controlled
15 micromirror positioned to redirect light from the light source toward the substrate; and
16 the reaction chamber, wherein the light redirected by the micromirror catalyzes a
17 chemical reaction proximate the substrate in the reaction are not apparent.

18 We observe that one of the notebook pages includes the word "mask" and an
19 arrow pointing to a region on the page in Garner I or Garner 0. Only a vague speckled
20 rectangle is visible. In any event, Garner has not explained what is shown by the
21 "mask" and how it demonstrates that a reaction was catalyzed proximate to the surface
22 of a substrate in the reaction chamber.

1 Thus, we conclude that Garner's declarations I and II, and the attached copies of
2 the photographs and notebook pages do not prove that the process of the proposed
3 count was actually reduced to practice.

4 Fondon I was submitted for the purpose of corroborating Garner's testimony.
5 (Application 09/998,341, Remarks dated October 24, 2005) Fondon testifies that he
6 saw a photograph of a prototype of a device in Dr. Garner's laboratory from November
7 of 1997. The photograph appears to be identical to one of the photographs attached to
8 Garner I and Garner II.

9
10 The Fondon declarations similarly fail to establish that the apparatus of the
11 proposed count was actually reduced to practice. Fondon's declaration refers to a copy
12 of a photograph that is said to show a prototype of a digital optical chemistry micromirror
13 imager, Fondon I and II, p. 1. The copy of the photograph appears to be the same as
14 one of the copies attached to Garner's declarations. Fondon does not testify how the
15 photograph demonstrates an actual reduction to practice of each element of the
16 apparatus of Garner's proposed count. Fondon, while testifying that he saw the device
17 shown in the photograph in Garner's laboratory in November 1997, does not testify that
18 the device contained the elements of the count or that they worked for their intended
19 purpose.

20 At best, the Fondon declarations corroborate the existence of a device
21 purportedly shown in the photographs. However, they do not prove or corroborate that
22 the device of the proposed count was operated and worked for its intended purpose.

1 The Fondon declarations, like Garner's, fails to establish that the apparatus of the count
2 was actually reduced to practice.

3 Garner's attachments to the declarations have been carefully reviewed.
4 However, absent testimony explaining how the copies of the photographs and notebook
5 pages show that all the elements of the proposed count were actually present and
6 achieved the desired result, Garner's evidence submitted October 24, 2005 and
7 January 26, 2006 fail to establish an actual reduction to practice and fail to prove that he
8 has a basis to prevail on priority. 37 CFR § 41.202(e).

9 D. Conclusion

10 As Garner has failed to show cause why judgment should not be entered against
11 it, judgment is entered against Garner in a separate paper filed today.

/Richard E. Schafer/
ADMINISTRATIVE PATENT JUDGE

/Jameson Lee/
ADMINISTRATIVE PATENT JUDGE

/James T. Moore/
ADMINISTRATIVE PATENT JUDGE

)
)
)
) BOARD OF PATENT
) APPEALS AND
) INTERFERENCES
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C

Effective: [See Text Amendments]

Code of Federal Regulations Currentness

Title 37: Patents, Trademarks, and Copyrights

Chapter I: United States Patent and Trademark Office, Department of Commerce (Refs & Amos)

Subchapter A: General

Practice Before The Patent and Trademark Office

Part 41: Practice Before The Board of Patent Appeals and Interferences (Refs & Amos)

Subpart E: Patent Interferences

§ 41.202. Suggesting an interference.

(a) Applicant. An applicant, including a reissue applicant, may suggest an interference with another application or a patent. The suggestion must:

(1) Provide sufficient information to identify the application or patent with which the applicant seeks an interference;

(2) Identify all claims the applicant believes interfere, propose one or more counts, and show how the claims correspond to one or more counts;

(3) For each count, provide a claim chart comparing at least one claim of each party corresponding to the count and show why the claims interfere within the meaning of § 41.203(a);

(4) Explain in detail why the applicant will prevail on priority;

(5) If a claim has been added or amended to provoke an interference, provide a claim chart showing the written description for each claim in the applicant's specification, and

(6) For each constructive reduction to practice for which the applicant wishes to be accorded benefit, provide a chart showing where the disclosure provides a constructive reduction to practice within the scope of the interfering subject matter.

(b) Patentee. A patentee cannot suggest an interference under this section but may, to the extent permitted under § 1.99 and § 1.291 of this title, alert the examiner of an application claiming interfering subject matter to the possibility of an interference.

(c) Examiner. An examiner may require an applicant to add a claim to provoke an interference. Failure to satisfy the requirement within a period (not less than one month) the examiner sets will operate as a concession of priority for the subject matter of the claim. If the interference would be with a patent, the applicant must also comply with paragraphs (a)(2) through (a)(6) of this section. The claim the examiner proposes to have added must, apart from the question of priority under 35 U.S.C. 102(g):

(1) Be patentable to the applicant, and

(2) Be drawn to patentable subject matter claimed by another applicant or patentee.

(d) Requirement to show priority under 35 U.S.C. 102(g).

(1) When an applicant has an earliest constructive reduction to practice that is later than the apparent earliest constructive reduction to practice for a patent or published application claiming interfering subject matter, the applicant must show why it would prevail on priority.

(2) If an applicant fails to show priority under paragraph (d)(1) of this section, an administrative patent judge may nevertheless declare an interference to place the applicant

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under an order to show cause why judgment should not be entered against the applicant on priority. New evidence in support of priority will not be admitted except on a showing of good cause. The Board may authorize the filing of motions to redefine the interfering subject matter or to change the benefit accorded to the parties.

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(e) Sufficiency of showing.

(1) A showing of priority under this section is not sufficient unless it would, if un rebutted, support a determination of priority in favor of the party making the showing.

(2) When testimony or production necessary to show priority is not available without authorization under § 41.150(c) or § 41.156(a), the showing shall include:

(i) Any necessary interrogatory, request for admission, request for production, or deposition request, and

(ii) A detailed proffer of what the response to the interrogatory or request would be expected to be and an explanation of the relevance of the response to the question of priority.

SOURCE: 69 FR 50003, Aug. 12, 2004, unless otherwise noted.

AUTHORITY: 35 U.S.C. 2(b)(2), 3(a)(2)(A); 21, 23, 32, 41, 134, 135.

37 C. F. R. § 41.202, 37 CFR § 41.202.

Current through: May 10, 2007; 72 FR.
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AD0028

CODE OF FEDERAL REGULATIONS
TITLE 37—PATENTS, TRADEMARKS, AND COPYRIGHTS
CHAPTER I—UNITED STATES PATENT AND TRADEMARK OFFICE, DEPARTMENT OF
COMMERCE
SUBCHAPTER A—GENERAL
PATENTS
PART 1—RULES OF PRACTICE IN PATENT CASES
SUBPART E—INTERFERENCES

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Current through July 1, 2004, 69 FR 40296

§ 1.608 Interference between an application and a patent; prima facie showing by applicant.

(a) When the effective filing date of an application is three months or less after the effective filing date of a patent, before an interference will be declared, either the applicant or the applicant's attorney or agent of record shall file a statement alleging that there is a basis upon which the applicant is entitled to a judgment relative to the patentee.

(b) When the effective filing date of an application is more than three months after the effective filing date of a patent, the applicant, before an interference will be declared, shall file evidence which may consist of patents or printed publications, other documents, and one or more affidavits which demonstrate that applicant is prima facie entitled to a judgment relative to the patentee and an explanation stating with particularity the basis upon which the applicant is prima facie entitled to the judgment. Where the basis upon which an applicant is entitled to judgment relative to a patentee is priority of invention, the evidence shall include affidavits by the applicant, if possible, and one or more corroborating witnesses, supported by documentary evidence, if available, each setting out a factual description of acts and circumstances performed or observed by the affiant, which collectively would prima facie entitle the applicant to judgment on priority with respect to the effective filing date of the patent. To facilitate preparation of a record (§ 1.653(g)) for final hearing, an applicant should file affidavits on paper which is 21.8 by 27.9 cm (8 1/2 x 11 inches). The significance of any printed publication or other document which is self-authenticating within the meaning of Rule 902 of the Federal Rules of Evidence or § 1.671(d) and any patent shall be discussed in an affidavit or the explanation. Any printed publication or other document which is not self-authenticating shall be authenticated and discussed with particularity in an affidavit. Upon a showing of good cause, an affidavit may be based on information and belief. If an examiner finds an application to be in condition for declaration of an interference, the examiner will consider the evidence and explanation only to the extent of determining whether a basis upon which the application would be entitled to a judgment relative to the patentee is alleged and, if a basis is alleged, an interference may be declared.

[60 FR 14520, March 17, 1995]

37 C.F.R. § 1.608

37 CFR § 1.608

END OF DOCUMENT

CODE OF FEDERAL REGULATIONS
TITLE 37—PATENTS, TRADEMARKS, AND COPYRIGHTS
CHAPTER I—UNITED STATES PATENT AND TRADEMARK OFFICE, DEPARTMENT OF
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SUBCHAPTER A—GENERAL
PATENTS
PART I—RULES OF PRACTICE IN PATENT CASES
SUBPART E—INTERFERENCES

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Current through July 1, 2004, 69 FR 40296

§ 1.617 Summary judgment against applicant.

(a) An administrative patent judge shall review any evidence filed by an applicant under § 1.608(b) to determine if the applicant is *prima facie* entitled to a judgment relative to the patentee. If the administrative patent judge determines that the evidence shows the applicant is *prima facie* entitled to a judgment relative to the patentee, the interference shall proceed in the normal manner under the regulations of this part. If in the opinion of the administrative patent judge the evidence fails to show that the applicant is *prima facie* entitled to a judgment relative to the patentee, the administrative patent judge shall, concurrently with the notice declaring the interference, enter an order stating the reasons for the opinion and directing the applicant, within a time set in the order, to show cause why summary judgment should not be entered against the applicant.

(b) The applicant may file a response to the order, which may include an appropriate preliminary motion under § 1.633 (c), (f) or (g), and state any reasons why summary judgment should not be entered. Any request by the applicant for a hearing before the Board shall be made in the response. Additional evidence shall not be presented by the applicant or considered by the Board unless the applicant shows good cause why any additional evidence was not initially presented with the evidence filed under § 1.608(b). At the time an applicant files a response, the applicant shall serve a copy of any evidence filed under § 1.608(b) and this paragraph.

(c) If a response is not timely filed by the applicant, the Board shall enter a final decision granting summary judgment against the applicant.

(d) If a response is timely filed by the applicant, all opponents may file a statement and may oppose any preliminary motion filed under § 1.633 (c), (f) or (g) by the applicant within a time set by the administrative patent judge. The statement may set forth views as to why summary judgment should be granted against the applicant, but the statement shall be limited to discussing why all the evidence presented by the applicant does not overcome the reasons given by the administrative patent judge for issuing the order to show cause. Except as required to oppose a motion under § 1.633 (c), (f) or (g) by the applicant, evidence shall not be filed by any opponent. An opponent may not request a hearing.

(e) Within a time authorized by the administrative patent judge, an applicant may file a reply to any statement or opposition filed by any opponent.

(f) When more than two parties are involved in an interference, all parties may participate in summary judgment proceedings under this section.

(g) If a response by the applicant is timely filed, the administrative patent judge or the Board shall decide whether the evidence submitted under § 1.608(b) and any additional evidence properly submitted under paragraphs (b) and (e) of this section shows that the applicant is *prima facie* entitled to a judgment relative to the patentee. If the applicant is not *prima facie* entitled to a judgment relative to the patentee, the Board shall enter a final decision granting summary judgment against the applicant. Otherwise, an interlocutory order shall be entered authorizing the

interference to proceed in the normal manner under the regulations of this subpart.

(b) Only an applicant who filed evidence under § 1.603(b) may request a hearing. If that applicant requests a hearing, the Board may hold a hearing prior to entry of a decision under paragraph (g) of this section. The administrative patent judge shall set a date and time for the hearing. Unless otherwise ordered by the administrative patent judge or the Board, the applicant and any opponent will each be entitled to no more than 30 minutes of oral argument at the hearing.

[50 FR 23124, May 31, 1985; 60 FR 14522, March 17, 1995]

37 C.F.R. § 1.617

37 CFR § 1.617

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The first identified threshold issue would be no interference-in-fact. Without an interference-in-fact, there would be no reason to place either party's claim in jeopardy in the context of an interference proceeding.

The other two specifically identified issues, the bar under 35 U.S.C. 135(b) and lack of written description under 35 U.S.C. 112(1), would be directed to the prevention of spuriously provoked interferences and would consequently be limited to motions from a party with a patent or published application against a party with an involved application. Note that the section 135(b) bar and lack of written description address complementary problems: Under section 135(b) a claim may be supported but untimely, while a claim lacking written description may be timely but is unsupported. For the purposes of the proposed rule, provocation of an interference would be inferred from the circumstances, such as entry of a claim after publication of the movant's application or issuance of the movant's patent. It would not require any determination that the opponent had an intent to provoke the interference.

Proposed § 41.202(a) would restate the requirements of Rules 604, 607, and 608 for applicants provoking an interference. A showing of priority need not anticipate all possible bases for opposing the showing. For instance, when the applicant's earliest constructive reduction to practice of the interfering subject matter occurred before the apparent earliest constructive reduction to practice of a targeted patent, it would typically suffice for the applicant to show precisely where its earliest constructive reduction to practice was disclosed.

Proposed § 41.202(a)(5) would continue the practice under Rule 633(a) of looking at the applicant's specification to determine the meaning of a copied claim, not the specification from which the claim was copied. See *Rowe v. Dror*, 112 F.3d 473, 479, 42 USPQ2d 1556, 1554 (Fed. Cir. 1997) (explaining the change in practice). It would also set forth a mechanism for weeding out frivolous attempts to provoke an interference. A protester under Rule 291 hoping to prompt an examiner to propose an interference could improve its chances of success by satisfying the requirements of proposed § 41.202(a)(1)-(a)(4) in its protest.

Proposed § 41.202(c) would restate the practice under Rule 605 of requiring an applicant to add a claim to provoke an interference. This requirement is an effective and sometimes necessary method for determining whether an interference actually exists between two parties. In *re Ogine*, 517 F.2d 1382, 1390, 186 USPQ 227, 235 (CCPA 1975). The requirement may be used to obtain a clearer definition of the interfering subject matter or to establish whether the applicant will pursue claims to the interfering subject matter. While an applicant must add the claim or forfeit the subject matter of the claim, the applicant may contest the requirement and the examiner may withdraw the requirement. Where the requirement is based on a patent or a published application, the examiner should note the patent or application in making the requirement. In challenging the requirement, the applicant may point to another claim in the application that already claims the subject matter of the required claim. The applicant may also propose an alternative claim with an explanation of why the alternative claim would be better for the purpose of determining the interference. A common reason for proposing an alternative claim is that the applicant believes the required claim to be unpatentable at least to the applicant.

Proposed § 41.202(d) would set forth the basis for a summary proceeding when an applicant does not appear to be able to show it would prevail on priority. Proposed § 41.202(d)(1) would restate Rule 608, but would eliminate the distinction between Rule 608(a) and Rule 608(b). The requirement could be made under 35 U.S.C. 132 even when a rejection is not available. Failure to comply with the requirement would result in abandonment of the application under 35 U.S.C. 133. Proposed § 41.202(d)(2) would restate Rule 617 by providing a basis for a summary proceeding on priority when the applicant fails to make a sufficient showing of priority. To be sufficient, under proposed § 41.202(e), the showing would by itself, if un rebutted, have to warrant a determination of priority.

Proposed § 41.203(a) would state the standard for declaring a patent interference.